

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : William Thomas, et al.
For : INTERACTIVE MEDIA GUIDE WITH MEDIA
GUIDANCE INTERFACE
Filed : April 10, 2001
Application No.: 09/829,806

Hon. Commissioner for Patents
Washington, D.C. 20231

Attention: Security Group
Licensing Review

PETITION FOR RETROACTIVE LICENSE
UNDER 35 U.S.C. § 184 AND 37 C.F.R. §§ 5.14(a) AND 5.25

Sir:

Petitioners, William Thomas, et al., respectfully request a retroactive license under 35 U.S.C. § 184 for this patent application, which, through error without deceptive intent, was filed in Argentina and Taiwan on April 10, 2001 without a foreign filing license.

An explanation detailing why the application was filed through error and without deceptive intent is found in the enclosed Declaration in Support of Petition for Retroactive License under 35 U.S.C. § 184.

This application was to be filed originally with only a claim to the benefit of U.S. Provisional Patent

Application No. 60/195,946, filed April 10, 2000 and was therefore to be filed by April 10, 2001.

On April 6, 2001, the undersigned was informed that the subject matter of the present application was related to Provisional Patent Application No. 60/202,306, filed May 5, 2000. Accordingly, a claim to the benefit to this provisional patent application was added. The application that was to claim benefit to Provisional Patent Application Number 60/202,306 was authorized to be filed abroad in Taiwan and Argentina.

On April 6, 2000, the undersigned was also informed that the present application, which was previously authorized to be filed abroad only under the Patent Cooperation Treaty, was now to be filed additionally in Taiwan and Argentina to match the foreign filing instructions for the application that was to claim benefit to Provisional Patent Application Number 60/202,306.

Foreign filing licenses in connection with the subject matter of the above-mentioned provisional applications were issued on June 8, 2000 and May 30, 2000, respectively.

On April 6, 2001, the undersigned was uncertain as to the existence of potential differences (if any) between the subject matter of this application and the subject

matter of the provisional applications and had insufficient time to determine the existence of any differences.

As a precautionary measure, a petition for an expedited foreign filing license was sent on April 6, 2001 to Cantwell & Paxton in Arlington, Virginia for filing with the U.S. Patent and Trademark Office. The petition was filed by hand on April 9, 2001. The Taiwanese and Argentinian patent applications were filed through error on April 10, 2001 because the undersigned understood that a license based on the petition was to be granted by April 10, 2001. However, the license was not granted until April 11, 2001, one day after the foreign filings.

The error requirement of 35 U.S.C. § 184 and 37 C.F.R. § 5.25 includes circumstances involving a mistake. In a January 18, 1991 final rulemaking directed toward part 5 of C.F.R. title 37 including 37 C.F.R. § 5.25, the Patent and Trademark Office stated that the "through error and without deceptive intent" criterion for a retroactive license is equivalent to the "through error and without any deceptive intention" criterion for obtaining reissue of a patent application. Patent Law Foreign Filing Amendments, 56 Fed. Reg. 1924, 1926 (Jan. 18, 1991). The Patent and Trademark Office also explained in that rulemaking that in cases, such as In re Wadlinger, 181 USPQ 826 (CCPA 1974);

this error requirement has been considered by the courts. 56 Fed. Reg. at 1926. In Wadlinger, the court explained that the word "error" as used in the relevant statute means "inadvertence, accident, or mistake," and that "'mistake' has a broad sweep and is certainly inclusive of actions taken in full consciousness." Id. at 832. Accordingly, the filing of the Argentinian and Taiwanese applications was through error because of the undersigned's mistake in believing in good faith that a license based on the expedited petition would be granted on or before April 10, 2001.

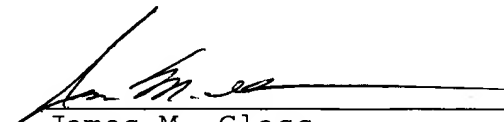
The foreign filings were without deceptive intent because the petition seeking a license to file the application in Taiwan and Argentina were placed before the U.S. Patent and Trademark Office before the foreign applications were filed. An intent to deceive the U.S. Patent and Trademark Office did not exist because petitioners by way of the petitions informed the U.S. Patent and Trademark Office of the impending filing of the foreign applications before actually filing the application in Taiwan and Argentina.

The subject matter of this application is unrelated to public safety, national defense, or national interests. The subject matter of this patent application is

related to electronic program guides. Electronic program guides are typically used to provide interactive television program guide features or services to television users. The subject matter of this application is particularly related to displaying listings of television programming for use by television viewers. Petitioners do not believe that the foreign filing of the attached application is detrimental to public safety or to the national interest or defense. The application does not disclose an invention within the scope of 35 U.S.C. § 181.

The Director of the Commissioner is authorized to charge the \$130.00 fee for this Petition to Deposit Account No. 06-1075. The Commissioner is also authorized to charge payment of any additional fee required under 37 C.F.R. § 1.17, or credit any overpayment of same to Deposit Account No. 06-1075. A duplicate copy of this Petition is enclosed.

Respectfully submitted,



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Enclosures